

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-16 were in the application, claims 1, 2, 5, and 9-11 have been amended; claims 14-16 have been withdrawn.

The Examiner objected to the drawings, and a replacement sheet is enclosed which includes the lead line and reference to hinge 41.

Claims 2, 5, 9 and 11 were objected to. These claims have been amended to overcome the objection. In addition, claim 1 has been amended to clarify the applicants' invention. In particular, the vertical recesses have been more positively recited to confirm that these are of a depth sufficient to securely mount the food processing device on a food utensil (p. 4, l. 10-15).

Claims 1, 2, 8 and 11 were rejected as being anticipated by Denter. However, Denter does not disclose each and every element of claim 1, and the rejection should be withdrawn.

To find anticipation, each and every element of the claim must be found in a single prior art reference. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220, U.S.P.Q. 303 (Fed. Cir. 1983). Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the art in possession of the invention. In re Spada, 15 U.S.P.Q.2d 1655 (Fed. Cir. 1990). An anticipatory reference must be enabling, containing adequate descriptions for practicing the applicant's invention. Akzo N.V. v. Intr'l Trade Comm., 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Denter does not anticipate the applicants' invention. While Denter shows a scalloped edge, this appears to be only used as a gripping surface and not one which would securely receive the rim, for example, of a bowl. Specifically, the indentations lack the depth necessary for securely mounting a food processing device over a bowl for receiving the sliced product during processing. Rather these appear as curved indents out of which a rim could easily slide during processing.

There is no disclosure in Denter that these indentations would or could be used for mounting over a utensil, and clearly one skilled in the art would not find an enabling disclosure

in Denter. Consequently, the rejection should be withdrawn.

Claims 1-4, 7-10, 12 and 13 were rejected as being obvious over Zeder et al in view of Denter.

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Systs. Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness based on a combination of references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In re Raynes, 7 F.3d 1037, 1039, 28 U.S.P.Q.2d 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991). As discussed in Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

Zeder discloses a food slicer with smooth sidewalls. No recesses or gripping surface is taught or suggested in Zeder. As discussed above, Denter does not discuss the indented edging, and these appear to be either finger gripping surfaces or means for gripping a flat surface. In either case, these indentations are inadequate for securely mounting the food slicer on a food utensil. There is no teaching or suggestion supporting the combination, and so the combination itself is improper. Further, even if the combination were made, it fails to provide a plurality of vertical recesses having sufficient depth for mounting securely on a food utensil, as shown for example in Figs. 5a and 5b. Consequently, claims 1-4, 7-10, 12 and 13 are believed patentable over the art cited by the examiner.

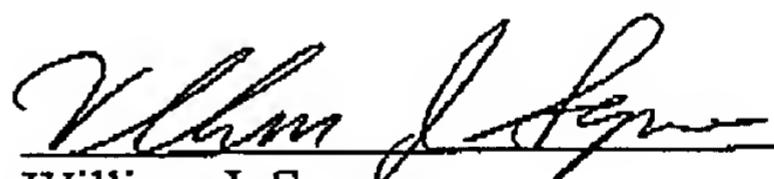
Claim 5 was rejected over the combination of Zeder and Denter as discussed above and further in view of Ranta, U.S. Patent no. 6,019,050. The discussion above is equally applicable

here and in particular, the legs of the applicants' claim 5 form the side walls and in accordance with claim 1, may contain the vertical recesses. There is no teaching or suggestion in the combination for incorporating such recesses in extending legs, as shown for example in Fig. 7a, and claim 5 is clearly patentable over the combination.

Claim 6 was rejected over the combination of Zeder and Denter as discussed above and further in view of Doyel, U.S. Patent no. 4,212,431. The discussion relative to the rejection of claim 1 over Zeder in view of Denter is equally applicable here, as the combination with Doyel does not provide for the vertical recesses in accordance with the applicants' invention. Consequently, claim 6 is similarly believed patentable over the cited art.

Based on the above amendments and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

  
William J. Sapone  
Registration No. 32,518  
Attorney for Applicant(s)

Coleman Sudol Sapone P.C.  
714 Colorado Avenue  
Bridgeport, CT 06605  
Telephone No. (203) 366-3560  
Facsimile No. (203) 335-6779